

REMARKS

Claim 10 is canceled. Claims 1, 12, 13, 18, 20, and 25 are amended. Claims 1-28 remain in the Application. Reconsideration of the pending claims is respectfully requested in view of the above amendment and the following remarks.

I. In the Specification

Applicants amend Specification at page 16, lines 19-21 to address the 35 U.S.C. § 101 rejection. Specifically, references to all forms of propagated signals are deleted. Approval of the amendment is respectfully requested.

II. Claims Rejected Under 35 U.S.C. § 112

Claim 13 stands rejected under 35 U.S.C. § 112, second paragraph as being indefinite. Applicants amended Claim 13 to replace “a hardware device” in line 2 with “the hardware device.” Applicants also amend Claim 20 to correct a typographical error by replacing “drive” with “driver.” Approval of the amendment is respectfully requested.

III. Claims Rejected Under 35 U.S.C. § 101

Claims 1-28 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. Applicants amend Claim 1 to more clearly point out that the claimed subject matter is implemented by a computer. The Examiner also alleges that the operations of Claim 1 could have been carried out by a person. However, Claim 1 recites “accessing a hardware device using the pre-boot driver.” As generally known in the art, a driver in the context of computer programming is an interface between a processor and a hardware device. A driver is designed for use by a machine, not by a person. A skilled person will not be able to use a driver for communicating with a hardware device. The Examiner further alleges that the operations of Claim 1 do not appear to produce a useful, concrete, and tangible result. Applicants submit that the operation of “accessing a hardware device” allows the hardware device to communicate with a processor, thus allowing a user to utilize the hardware device. Allowing a user to access a hardware device is a useful, concrete, and tangible result within the contemplation of the statute.

Similarly, amended Claims 12 and 18 and original Claim 25 recite that tangibly-embodied instructions are executed by a processor. The operations of “loading a pre-boot driver image,” “executing a pre-boot driver image,” and “initializing an expansion board” recited by these claims are machine operations. A skilled person will not be able to carry out these operations without using a computer or a processor. These operations also facilitate the communication between a computer/processor and a hardware device coupled thereto. As a result, the user is able to utilize the hardware device. Thus, these independent claims and the claims dependent therefrom recite statutory subject matter.

With respect to the rejection that propagated signals are non-physical media, Applicants amend specification at page 16, lines 19-21 to delete the references to all forms of propagated signals. Approval of the amendment is respectfully requested.

IV. Claims Rejected Under 35 U.S.C. § 102

Claim 1-3, 11-14, 18, and 25 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application No. 2004/0215950 A1 issued to Lindeman (“Lindeman”). Applicants respectfully traverse the rejection.

To anticipate a claim, the Examiner must show that a single reference teaches each of the elements of that claim. Claim 1 is amended to incorporate all of the limitations of canceled Claim 10. Claim 1 recites:

“A computer-implemented method, comprising:
requesting to access a hardware device of a computer system during operating system (OS) runtime of an operating system executing on the computer system;
accessing the hardware device using an OS native driver for the hardware device if the OS native driver is available to the operating system;
finding a pre-boot driver for the hardware device by the computer system if the OS native driver is not available to the operating system; and
accessing the hardware device during the OS runtime using the pre-boot driver if the OS native driver is not available to the operating system.” (Emphasis Added).

Applicants submit that Lindeman at least does not teach the claimed operations of “accessing the hardware device....if the OS native driver is available to the operating system,”

and the operations of “finding....and accessing....if the OS native driver is not available to the operating system.”

Lindeman discloses loading a boot-time open firmware into a computer system. Based on an image of the boot-time open firmware, a runtime version of the open firmware is established (paragraph 37). The runtime version is an instantiation of the boot-time open firmware having different portions of the boot-time open firmware code enabled (paragraph 37). During OS runtime, the runtime open firmware passes device information to the operating system (FIG. 6, paragraphs 52-53).

Lindeman does not teach accessing the hardware device using an OS native driver for the hardware device if the OS native driver is available to the operating system. Lindeman also does not teach finding a pre-boot driver for the hardware device and accessing the hardware device during the OS runtime using the pre-boot driver if an OS native driver is not available to the operating system. Lindeman in fact recommends against using two different types of firmware, one for boot-time and the other for operating system runtime (paragraph 6). As disclosed by Lindeman, only one firmware code should be used. The boot-time and runtime versions of Lindeman's open firmware are the same firmware code with different portions enabled. Thus, Lindeman does not disclose using an OS native driver when it is available and using a pre-boot driver when the OS native driver is not available.

Analogous discussions apply to independent Claims 12, 18, and 25. In regard to Claims 2, 3, 11, 13, 14, and other dependent claims not specifically rejected by the Examiner, these claims respectively depend from Claims 1, 12, 18, and 25 and incorporate the limitations thereof. Thus, at least for the reasons mentioned above in regard to Claim 1, Lindeman does not anticipate these claims. Accordingly, reconsideration and withdrawal of the anticipation rejection are respectfully requested.

V. Claims Rejected Under 35 U.S.C. § 103(a)

Claims 5, 6, 15, 20 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lindeman in view of U.S. Patent No. 6,219,828 issued to Lee (“Lee”). Applicants respectfully traverse the rejection.

To establish a *prima facie* case of obviousness, the relied upon references must teach or suggest every limitation of the claim such that the invention as a whole would have been obvious at the time the invention was made to one skilled in the art.

Claims 5 and 6 depend from Claim 1 and incorporate the limitations thereof. Thus, for at least the reasons mentioned above in regard to Claim 1, Lindeman does not teach or suggest each of the elements of Claims 5 and 6.

Lee does not cure the deficiency of Lindeman. Lee is relied on for teaching a pre-boot driver interpreter. However, Lee merely discloses operations (e.g., debugging) performed before the operating system is installed (Technical field). Thus, there is nothing in Lee that teaches or suggests the claimed operations which are performed during the OS runtime. Thus, Lindeman in view of Lee does not teach or suggest “accessing the hardware device using an OS native driver for the hardware device if the OS native driver is available to the operating system” and “accessing the hardware device during the OS runtime using the pre-boot driver if the OS native driver is not available to the operating system” as claimed in Claim 1 and its dependent Claims 5 and 6.

Analogous discussions apply to Claims 15, 20 and 22. Accordingly, reconsideration and withdrawal of the obviousness rejection of Claims 5, 6, 15, 20 and 22 are requested.

CONCLUSION

In view of the foregoing, it is believed that all claims now are now in condition for allowance and such action is earnestly solicited at the earliest possible date. If there are any additional fees due in connection with the filing of this response, please charge those fees to our Deposit Account No. 02-2666.

Respectfully submitted,

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